

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q89966

Yukihiro SHIGEMURA

Appln. No.: 10/549,667

Group Art Unit: 1794

Confirmation No.: 3758

Examiner: Nicole T. GUGLIOTTA

Filed: September 19, 2005

For: POLYESTER COMPOSITE THICK AND FINE YARN AND METHOD FOR PROCESS
FOR PRODUCING SAME, AND METHOD FOR PRODUCTION THEREOF AND
WOVEN OR KNITTED FABRIC THEREFROM

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated October 28, 2008, Applicant elects
Group I, claims 1 - 4, 6 - 9, and 13 - 20, for examination.

Respectfully, this election is made with traverse.

On page 2 of the Office Action, Applicant was required to elect one of the following
groups for prosecution on the merits:

Group I Claims 1 - 4, 6 - 9, and 13 - 20, drawn to a composite yarn; and

Group II Claims 5 and 10 - 12, drawn to a process for making a composite yarn.

Applicant respectfully disagrees with the basis for the restriction requirement. On page 2, the Office Action seems to assert that restriction is proper because the product claims of Group I can be obtained by a different process than the process steps recited in Group II.

However, Applicant respectfully submits that this requirement is not the proper test for unity of invention. According to MPEP § 1850, restriction of a process claim for making a product is improper if the process is “specially adapted” for the manufacture of said product. Moreover, “a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process.” MPEP § 1850. In the present application, the process claims of Group II necessarily produce the products according to the claims of Group I, including their technical relationships, because the process claims of Group II incorporate the requirements of the recited product claims.

Therefore, Applicant respectfully submits that the process claims of Group II are specially adapted to manufacture the products of Group I and restriction between these groups is improper.

Applicant respectfully submits that reconsideration and withdrawal of the restriction requirement is proper. Such actions are hereby earnestly solicited.

In addition, Applicant submits that if any of the elected claims are found to be allowable, claims dependent therefrom should similarly be considered allowable in the same application.

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Attorney Docket No. Q89966

Applicant reserves the right to file a Divisional Application directed to non-elected claims 5 and 10 - 12.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

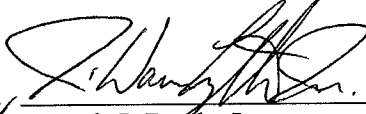
Respectfully submitted,

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WASHINGTON OFFICE

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Date: November 28, 2008